UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,455	09/15/2003	David Abu Ghazaleh	RSW920030055US1	2196

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EXAMINER
VU, TUAN A

ART UNIT	PAPER NUMBER
2193	

MAIL DATE	DELIVERY MODE
02/05/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Advisory Action ***Before the Filing of an Appeal Brief***	*10/663,455*	GHAZALEH ET AL.
	Examiner	Art Unit
	TUAN A. VU	2193

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 January 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

    a) ☐ The period for reply expires _____months from the mailing date of the final rejection.

    b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

        Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because

    (a)☒ They raise new issues that would require further consideration and/or search (see NOTE below);

    (b)☐ They raise the issue of new matter (see NOTE below);

    (c)☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

    (d)☐ They present additional claims without canceling a corresponding number of finally rejected claims.

        NOTE: *See Continuation Sheet.* (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

    The status of the claim(s) is (or will be) as follows:

    Claim(s) allowed: _____.

    Claim(s) objected to: _____.

    Claim(s) rejected: *1-35*.

    Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:

    _____.

12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____.

                              /Tuan A Vu/
                              Examiner, Art Unit 2193

 Continuation of 3. NOTE: Regarding the claim amendments, further consideration would be needed, hence will not be entered to not further complicate effects on an Appeal. The claimed subject matter of claim 1, excluding the proposed changes, will stand rejected. Regarding the arguments about Kodosky not teaching 'denoting' a main object, 'denoting' (based on the scant language in the claim) has been interpreting as graphically circling/framing around a object, and the office has interpreted this as highlighting objects by the user, and there is no requirement for the Office to explain why the claim has been mapped with the reference (the interpretation as it is) beyond the rationale of the rejection. The argument clearly fails to point out where Bailey cannot be combined with Kodosky. Further, it is utterly questionable whether highlighting a object is a automated software action or a user manual intervention, hence as it stands the 'denoting' is treated as the underlying API that render user action visible. That is, responsive to user clicking, the software renders visible a peripheral area of the selected object, since 'denoting' as recited remains a very scant amount of teaching for one to construe a action being inventive. The claim does not provide sufficient specificity as to whether showing a main object more "main" by way of automated code instructions or from clicking by the user. And arguing that the user in Kodosky fails to teach such 'denoting' is not commensurate with the vague (re claim 3) language of the claim; i.e. novelty not clearly non-obvious over any action made by any user when graphically the user can highlight a object. The argument is therefore not convincing. As for claim 7, the argument would be moot because of the proposed change (thereto) being not part of the record. The arguments regarding claim 10, 13, 14, 16 fail to point out exactly where combination of teachings as effectuated would not be appropriate; and mere pleading or disagreeing verbally alone cannot constitute factual grounds to overcome the rejection. As for claim 19 and the alleged 'new grouds of rejection' adopted by the Office, claims 13 and 19 fall under the scope of the 103 combination of Kodosky and Bailey: the grounds of rejection remain unchanged. As for the argument that line joining two objects in Kodosky fails to teach first object 'not invoking' the other object, there are insufficient facts presented to confirm that lines in Kodosky actually are used solely to represent code invocation between 2 joined objects; hence the argument is largely unfounded. The claims in all will stand rejected and the proposed changes will not entered. It is also noted that should the arguments be maintained in regard to the currently claimed GUI-based actions, care should be taken to only point out where graphical capabilities of the present invention distinguish (in a non-obvious manner) over the well-known features in graphical tool so to clearly obviate implicating user manual intervention, because user usage of a tool cannot be integral part of any invention; i.e. arguing on possible variations of a GUI events which are realized solely based on a human/designer's behavior/acts (e.g. drawing a line, joining two objects) would be deemed useless in order to promote or put forth a remote patentability of the case